



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/776,861	02/06/2001	Hiroshi Sasaki	MA-470-US	6868

466 7590 06/28/2004

YOUNG & THOMPSON
745 SOUTH 23RD STREET 2ND FLOOR
ARLINGTON, VA 22202

EXAMINER

PATEL, HARESH N

ART UNIT	PAPER NUMBER
----------	--------------

2154

6

DATE MAILED: 06/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/776,861

Applicant(s)

SASAKI, HIROSHI

Examiner

Haresh Patel

Art Unit

2154

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 February 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 February 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2-5.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Art Unit: 2154

DETAILED ACTION

1. Claims 1-25 are presented for examination.

Priority

2. Applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d) or (f), is acknowledged.

Applicant is requested to submit the translation document of the priority.

Specification

3. The section "BRIEF SUMMARY OF THE INVENTION" is objected. This section must not contain claim language and repetitive information. As per the title of this section, the summary needs to be brief.

4. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: "Conversion of web image for portable device based on web browser image size/quality selection".

Information Disclosure Statement

5. An initialed and dated copy of Applicant's IDS form 1449, Paper No. 2-5, is attached to the instant Office action.

Claim Rejections - 35 USC § 112

Art Unit: 2154

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1-3, 6, 8 and 9 are rejected under 35 U.S.C. 112, first paragraph, Single Means Claim.

A single means claim, i.e., where a means recitation does not appear in combination with another recited element of means, is subject to an undue breadth rejection under 35 U.S.C. 112, first paragraph. In re Hyatt, 708 F.2d 712, 714-715, 218 USPQ 195, 197 (Fed. Cir. 1983) (A single means claim which covered every conceivable means for achieving the stated purpose was held nonenabling for the scope of the claim because the specification disclosed at most only those means known to the inventor.). When claims depend on a recited property, a fact situation comparable to Hyatt is possible, where the claim covers every conceivable structure (means) for achieving the stated property (result) while the specification discloses at most only those known to the inventor.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Art Unit: 2154

8. Claims 1-25 are rejected under 35 U.S.C. 102(e) as being anticipated by Adams et al. 6,457,030 (Hereinafter Adams).

9. As per claims 1, 10, 14 and 18, Adams teaches a method, a system and a computer readable memory to implement data conversion as follows:

a terminal device belonging to a first communication network (hand held device display, col., 2, lines 13 – 47),

a server device (e.g., web server, col., 2, lines 2 – 26) belonging to a second communication network having a protocol (e.g., http, col., 1, lines 11 – 30) different from that of said first communication network (e.g., WAP, col., 7, lines 55-57) and a protocol conversion device provided at a connection point (e.g., proxy server, col., 7, line 37 – col., 8, line 13) between said first communication network and said second communication network for conducting protocol conversion (e.g., data conversion from one protocol to another, col., 7, line 37 – col., 8, line 13),

adding constraint information (e.g., Fidelity, col., 8, lines 45 – 61) peculiar to said terminal device (e.g., handheld device, col., 2, lines 13 – 47) to a request from said terminal device for obtaining predetermined contents (e.g., existing images, col., 8, lines 45 – 61) from said server device and transmitting the obtained request to said protocol conversion device (e.g., use of transcoder/transformer logic, col., 7, line 37 – col., 8, line 13),

receiving said constraint information from said terminal device (e.g., processing of handheld device browser input/setting information, col., 2, lines 7 – 7) to convert predetermined

Art Unit: 2154

contents obtained from said server device into data based on said constraint information (e.g., handheld device browser provided information used by transcoder/transformer logic for data conversion, col., 7, line 37 – col., 8, line 13).

10. As per claims 2-9, 11-13, 15-17 and 19-25, Adams teaches the following:

determine whether predetermined contents obtained from said server device are image data or not and when said predetermined contents are image data, converts said predetermined contents into data based on said constraint information (e.g., use of transcoder/transformer logic for data conversion, col., 7, line 37 – col., 8, line 13),

data conversion means is provided at said protocol conversion device (e.g., use of transcoder/transformer logic for data conversion at a proxy server, col., 7, line 37 – col., 8, line 13),

storage means for storing said constraint information from said terminal device, wherein said data conversion means converts predetermined contents obtained from said server device based on said constraint information stored in said storage means (e.g., use of stored information by the transcoder/transformer logic for data conversion, col., 7, line 37 – col., 8, line 13),

protocol conversion device includes: said data conversion means and storage means for storing said constraint information from said terminal device, said data conversion means converting predetermined contents obtained from said server device based on said constraint information stored in said storage means (e.g., accessing the stored information by the transcoder/transformer logic for data conversion, col., 7, line 37 – col., 8, line 13),

Art Unit: 2154

data conversion means is provided at said server device (e.g., use of transcoder/transformer logic for data conversion at a web server, col., 7, line 37 – col., 8, line 13),

protocol conversion device transmits said request received from said terminal device and said constraint information added to said request to said server device (e.g., transmission of WAP requests with the addition of height, width, etc. by the hand held device, col., 8, lines 16 – 61), and said server device includes storage means for storing said constraint information from said protocol conversion device (e.g., use of storage mechanisms at web server for handheld provided information, col., 7, line 37 – col., 8, line 13) and said data conversion means for converting said predetermined contents based on said constraint information stored in said storage means (e.g., use of transcoder/transformer logic, col., 7, line 37 – col., 8, line 13),

constraint information includes at least one of size information of images (e.g., height, width, col., 8, lines 45 – 61) and gradation information of images (e.g., fidelity, col., 8, lines 45 – 61),

first communication network is a communication network for portable information terminals (e.g., use of WAP, col., 7, lines 55-57) and said second communication network is the Internet (e.g., use of HTTP and internet, col., 1, lines 11 – 30),

data conversion step includes the steps of: determining whether predetermined contents obtained from said server device are image data or not (e.g., processing of image data differently than other data types, col., 5, lines 60-67), and when said predetermined contents are image data, converting said predetermined contents into data based on said constraint information (e.g.,

Art Unit: 2154

handheld device browser provided information used by transcoder/transformer logic for data conversion, col., 7, line 37 – col., 8, line 13).

Conclusion

11. The international search report submitted by the applicant also anticipates the concept of the applicant's claimed invention.

12. Examiner makes a very clear note that the rational of the applicant's invention has been clearly anticipated by the cited reference. Applicant's invention does contain few minor additional matters that facilitate the concepts of the applicant's invention. However, the additional minor matters are well known in the art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Haresh Patel whose telephone number is (703) 605-5234. The examiner can normally be reached on Monday, Tuesday, Thursday and Friday from 10:00 am to 8:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee, can be reached at (703) 305-8498.

The appropriate fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Haresh Patel

June 15, 2004



JOHN FOLLANSBEE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100